

Remarks and Arguments

Claims 1, 2, and 4-28 are pending in this case. Claim 1 has been amended to particularly point out the invention. Support for this amendment is found in the specification on page 8, lines 23-24. New claims 29 and 30 have been added to particularly point out the invention. Support for these amendments is found in the specification on page 7, line 5- page 8, line 9 and page 5, lines 14-15. Applicants gratefully acknowledge that the Examiner has found claims 26 and 28 to be free of the prior art and in condition for allowance.

Claim Objections

The Office objects to the wording of claim 27, alleging that energy cannot be delivered “for” a period of time, but rather must be delivered over a period of time. While not agreeing with the objection, Applicants have, nonetheless, amended claim 27 to recite “over,” thus obviating the objection.

Anticipation Under 35 U.S.C. § 102(e)

Claims 1, 2, and 6-25 stand rejected under 35 U.S.C. § 102(e) as allegedly anticipated by U.S. Patent No. 6,443,976 (hereinafter “’976”). The Examiner alleges that the ’976 patent teaches a method for treating a lesion such as CNV or a tumor. According to the Office the method contemplates subjecting the lesion to PDT and subjecting a blood vessel that carries blood into the lesion to thermal photocoagulation to reduce blood flow through that vessel into the lesion. The Office further alleges that the ’976 patent teaches that a fluorescent dye may be used to obtain angiograms of the vasculature of interest to permit accurate targeting and radiation absorbing dye may be used in dye enhanced feeder vessel photocoagulation.

The standard for anticipation under 35 U.S.C. § 102 requires that each and every element as set forth in the claim be found, either expressly or inherently described, in a single prior art reference.” *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 U.S.P.Q.2d 1051, 1053 (Fed. Cir. 1987). “The identical invention must be shown in as complete detail as is contained in the...claim.” *Richardson v. Suzuki Motor Co.*,

868 F.2d 1226, 1236, 9 U.S.P.Q.2d 1913, 1920 (Fed. Cir. 1989). Each and every element of the amended claim is not set forth in the '976 patent.

The Office admits that a rapid bolus is not disclosed in the '976 patent (page 4 of the Office Action dated May 25, 2005). Applicants submit that a bolus injection, as recited in amended claim 1, is not disclosed in the '976 patent and thus the rejection under 35 U.S.C. § 102(e) is obviated. Claims 2, and 6-25 depend on claim 1. Moreover, any rejection based upon combining the '976 reference with U.S. Patent No. 6,351,663 ('663) must fail for reasons set forth below in the discussion regarding claim 4.

The Office also alleges that claims 22-25 are "implicitly" anticipated by the '976 patent but fails to point out a specific line or paragraph in '976 that supports this position. Applicants respectfully request that the Office particularly point out where the '976 patent implicitly suggests the angiographic images may be used to determine the rate the composition exits the lesion. If the Office is relying on personal knowledge to support this rejection, Applicants respectfully request that the Examiner submit an affidavit under 37 CFR 1.104(d) or alternatively withdraw the rejection.

Obviousness Under 35 U.S.C. § 103

Claim 4

Claim 4 stands rejected under 35 U.S.C. § 103 as allegedly unpatentable over the '976 patent in view of the '663 patent. The Office admits that '976 does not disclose administration of the composition as a rapid bolus, but nonetheless alleges the claim is obvious in view of the '663 patent because, according to the Office, '663 teaches the introduction of a liquid composition for CNV treatment as boluses comprising a fluorescent dye. The Office alleges it would have been obvious to introduce the dye as a bolus "as an alternative equivalent means of introduction" (emphasis added).

The Prima Facie Case Requirement

The Patent and Trademark Office (PTO) bears the burden of initially establishing a prima facie case of obviousness. MPEP § 2142. MPEP § 2143 provides the standard required to establish a prima facie case of obviousness. "First there must be some

suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine what the reference teaches. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references combined) must teach or suggest all the claim limitations.”

The motivation to make the claimed invention and the reasonable expectation of success must both be found in the prior art, not the applicant's disclosure. *In re Vaeck*, 20 U.S.P.Q.2d 1438, 1442 (Fed. Cir. 1991). The references must be considered as a whole and must suggest the desirability, and thus the obviousness of making the combination. *Hodosh v. Block Drug Co., Inc.*, 229 U.S.P.Q. 182, 187 n.5 (Fed. Cir. 1986); MPEP § 2141.

The Prima Facie Case Requirement Has Not Been Satisfied

The PTO has not met its burden in the instant case because the references do not suggest the desirability of making the combination. Motivation to combine the references is therefore lacking. The Office is urged to consider *Winner v. Wang*, 202 F.3d 1340, 1349, 53 U.S.P.Q.2d 1580, 1587 (Fed. Cir. 2000). In this case the Federal Circuit stated that a claim may not be rendered obvious where there is no perceived problem to be solved (i.e. where each reference recites an acceptable solution to the same problem). The Office has admitted that both references recite “alternative equivalent means of introduction,” and thus recite alternative solutions to the same problem. Accordingly, no perceived problem existed that would motivate an artisan to combine the references as suggested by the Office. Because no motivation to combine the references existed, the prima facie case must fail. Accordingly, Applicant’s respectfully request that this rejection be withdrawn.

Claim 5

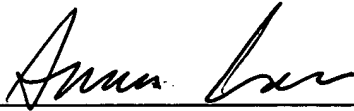
Claim 5 stands rejected under 35 U.S.C. § 103 as allegedly unpatentable over the ‘976 patent in view of the ‘663 patent as applied to claim 4 and further in view of U.S. Patent No. 5,707,986 (‘986). The Office admits that neither ‘976 nor ‘663 disclose a saline flush, but alleges that that the ‘986 patent does. Claim 5 depends on claim 4

thus this rejection must fail for the same reasons set forth above regarding claim 4.
Accordingly, Applicants respectfully request withdrawal of the rejection.

CONCLUSION

In view of the foregoing remarks, Applicants respectfully request the reconsideration and reexamination of this application and the timely allowance of the pending claims.

Respectfully submitted



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